



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re the Application of: **Hiroyuki SEKITANI**

Group Art Unit: **3625**

Serial Number: **09/880,036**

Examiner: **Mark A. Fadook**

Filed: **June 14, 2001**

Confirmation No.: **5953**

For: **PART RETRIEVING SYSTEM FOR PRODUCTION MACHINES
UTILIZING NETWORK**

Attorney Docket Number: **010734**

Customer Number: **38834**

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Date: 24 May 2006

Sir:

In response to the Examiner's Answer mailed on May 1, 2006, the following is the

Appellant's Reply Brief.

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By: Takahashi AKAMATSU
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APPELLANT'S ARGUMENT

Treatment under 35 U.S.C. §112, sixth paragraph

Appellant notes that the Examiner states the following with regard to 35 U.S.C. §112, sixth paragraph: "Applicant's non response to the previous request to indicated [sic] USC 112 intention is now considered prosecution history estoppel indicating that the applicant does not wish to invoke USC 112 6th paragraph." Examiner's Answer, page 3

According to MPEP §2181, which applies *In re Donaldson*, 16 F. 3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994):

A claim limitation will be interpreted to invoke 35 U.S.C. 112, sixth paragraph, if it meets the following 3-prong analysis:

- (A) the claim limitations must use the phrase "means for" or "step for;"
- (B) the "means for" or "step for" must be modified by functional language; and
- (C) the phrase "means for" or "step for" must not be modified by sufficient structure, material or acts for achieving the specified function.

Appellant argues that the pending claims meet all three prongs, since they utilize the phrase "means for," the phrase is modified by functional language, and the phrase is not modified by sufficient structure.

Further, MPEP §2181 requires:

If a claim limitation does include the phrase "means for" or "step for," that is, the first prong of the 3-prong analysis is met, but the examiner determines that either the second prong or the third prong of the 3-prong analysis is not met, then in these situations, the examiner must include a statement in the Office action explaining the reasons why a claim limitation which uses the phrase "means for" or "step for" is not being treated under 35 U.S.C. 112, sixth paragraph.

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Such a statement does not appear in the prosecution history. The Examiner is arguing that the claims are not read in the context of 35 U.S.C. §112, sixth paragraph, simply because Appellants have not formally “invoked” the sixth paragraph. According to page 2 of the July 29, 2005 Office Action, “it is the applicant’s responsibility to invoke USC 112 6th paragraph.” Appellants argue that no such invocation is required. The claims should therefore be interpreted according to the 35 U.S.C. §112, sixth paragraph, as required by statute.

Placement of the “Local Database”

The Examiner states that the “Local Database is clearly detached from the workstation computer (what the examiner is equating as appellant’s terminal). Since the database is detached a connection such as a hard wire is required to connect the two devices.” Examiner’s Answer, page 5. The Examiner further argues that such a connection would be a network.

Appellant argues that this is inconsistent with the disclosure of Calloway. Based on the disclosure of Calloway, the elements within the dotted line in Figure 1B are hardware components of the EMS workstation 10, connected by a bus. While these components may or may not be connected using hardwires, such a connection would not be a network. Workstation computer 24 “interfaces” with text screen 12, video/graphics screen 14, video/graphics interface hardware 22, audio, local database, work station computer 24, video disk 15 and modem. These are simply peripherals which one having ordinary skill in the art would understand as being connected by a bus, not a network.

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As pointed out by the Examiner, a network is “a group of computers and associated devices that are connected by communications facilities.” Thus, it appears that the Examiner argues that workstation computer 24 is a computer, that at least Local Database is also a computer, and that workstation computer 24 and local data base form a network. In response, Appellants argue that Calloway does not provide support for this argument, and instead discloses in Figure 1B an EMS workstation (contained within the dotted line) which includes several hardware components linked via a bus, not a network.

Appellant concedes that the connection between the modem of the EMS workstation and the central computer 26 is a communications network for bidirectional communication. However, Appellant strongly argues that the *Local* Database is disposed *locally*, within an EMS workstation, rather than being connected to a terminal via a communication network for bidirectional communication.

Finally, it is noted that the Examiner’s current position is inconsistent with the Examiner’s earlier position in the Office Action dated September 15, 2005, where the Examiner stated on page 5 that “the workstation computer 24 is in bi-directional communication with the central computer 26, which is depicted in Figure 1A and contains the database part files.” The Examiner now appears to abandon the position that the database part files are contained within central computer 26.

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Additional Comments

The Examiner now argues that even if the local database is not on a network, it would have been obvious to place the database anywhere on the network, because rearranging of parts of an invention involves only routine skill in the art.

First, Appellants argue that the appealed rejection is under 35 U.S.C. §102(b), not 35 U.S.C. §103. Therefore this argument is misplaced. However, with regard to a potential rejection under 35 U.S.C. §103:

“The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device.” *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984).

Thus, even if a rejection under 35 U.S.C. §103 were at issue, the Examiner's argument would be improper without a showing of motivation in the art to make such changes.

Thus, for at least the above reasons, Appellant requests that the Honorable Board reverse the Examiner's rejection.

REPLY BRIEF

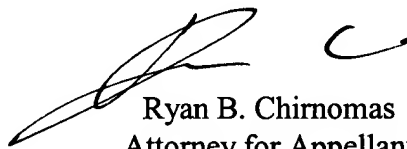
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If this paper is not timely filed, appellants hereby petition for an appropriate extension of time. The fee for any such extension may be charged to our Deposit Account No. 50-2866, along with any other additional fees that may be required with respect to this paper.

Respectfully submitted,

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RBC/jl